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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 03-1343

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Application Number	Filed
10/701,332	November 4, 2003
First Named Inventor	
Ghasi R. Agrawal	
Art Unit	**Examiner**
2117	Steve N. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 39979
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

James R. Foley
Typed or printed name

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Telephone number

July 13, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

REASONS FOR REVIEW

In the most recent Office Action, the Examiner continues to reject all the claims (claims 15-17, 19-23 and 25-26) under 35 U.S.C. §103(a) as being unpatentable over a combination of four references -- United States Patent No. 6,961,880 (Frankowsky), United States Patent Publication No. 2003/0237061 (Miller et al.), United States Patent No. 6,661,719 (Shih) and United States Patent No. 6,999,357 (Tanishima et al.).

Claims 15 and 21 are independent. Claim 15 specifically claims a method for testing memory which comprises the steps of performing a first test, wherein functional memory is tested; repairing the functional memory by adding access to redundant elements, thereby providing repaired functional memory; performing a second test, wherein the repaired functional memory is tested; adding access to redundant memory not required for repair of the functional memory after repairing the functional memory and after testing the repaired functional memory; and after testing the repaired functional memory and then adding access to redundant memory not required for repair of the functional memory, performing a third test, wherein the redundant memory is tested, wherein the step of adding access to redundant memory which is not required for the repair comprises faking defects to remap good elements with redundant elements. Claim 21 is similar but is directed to a mode.

Applicant respectfully asserts that none of the cited references, whether alone or in combination, disclose or suggest what is being specifically claimed in the claims of the present application. For example, none of the cited references disclose testing functional memory, repairing the functional memory by adding access to redundant elements, testing the repaired functional memory, adding access to redundant memory not required for the repair comprising faking defects to remap good elements with redundant elements, and then testing the redundant memory.

Applicant respectfully submits that there are many differences between what is being claimed and what is disclosed in the cited references, and that the Examine has used hindsight to cherry pick from four different references to arrive at the present invention. There are many court decisions which hold that using hindsight is improper. As early as 1891, the United States Supreme Court held that:

> Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as further evidence, even as demonstration . . . Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor . . . It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved.

Diamond Rubber Co. v. Consolidated Rubber Tile Co., 220 U.S. 428 , 435-36.

Additionally, Applicant respectfully asserts that the Examiner has misinterpreted the references. For example, the Examiner admits that Frankowsky fails to disclose the step of adding access to redundant memory which is not required for the repair comprising faking defects to remap good elements with redundant elements, but asserts that Tanishima discloses this. Applicant respectfully traverses.

While the Examiner asserts that Tanishima et al. discloses faking defects to remap good elements with redundant elements, this is not the case. Tanishima et al. discloses replacing a **failed** memory cell array with a redundant memory cell array (see col. 6, lines 31-34 ("it is possible . . . to replace the **failed** memory cell array with the redundant memory cell array"; col.

7, lines 5-9 ("This allows the **failed** portion data written in the fuses to be transferred . . . . The **failed** portion data . . . is then outputted"); and col. 8, line 4 ("without writing of the **failed** portion data")).

With regard to the sections of Tanishima et al. cited by the Examiner, namely col. 7, lines 34-37, 37-42 and 48-55, Applicant wishes to point out what is disclosed at lines 34-37 ("when testing of the redundant memory cell is performed in the testing step, **test data is fed as the failed portion data to the I/O terminals**...") and lines 48-50 ("**depending on the test data** . . . **one of the memory cell arrays is replaced** . . . ."), and respectively asserts that Tanishima et al. fails to discloses adding access to redundant memory which is not required for repair, and then testing the redundant memory. In Tanishima et al., access is added because repair is or would be required.

Applicant respectfully submits that none of the references, whether alone or in combination, disclose or suggest the present invention as claimed. In view of the above amendments and remarks, Applicant respectfully requests that the present application be passed to issuance.

Respectfully submitted,

Date: July 22, 2010

By: _____

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